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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDALL ALLEN VOGEL, I HWA LEE, SUMITA SANJEEVI
RANGANATHAN, and LORI J. PIKE,

Appellants.

Appeal 2009-013616
Application 09/833,452
Technology Center 1700

Decided: June 28, 2010

Before SALLY GARDNER LANE, RICHARD TORCZON, and SALLY C.
MEDLEY, *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

The appeal, under 35 U.S.C. § 134(a), is from a Final Rejection of Appellants' claims 1, 3, 6, 43, 54, 55, 57-60, 66-72, 83, and 84. Claims 2, 4, 5, 7-42, 44-53, 56, 61-65 and 73-82 were cancelled by Appellants. (*See* Amendment transmitted July 13, 2007, pp. 3-5). We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part and enter a new grounds of rejection.

Appellants' specification is directed to multilayer sheets that can be used for surfacing parts, such as automotive, appliance and general aviation parts. (Spec. p. 5, ll. 6-10). Appellants' claims are not limited to these uses, though. (*See* App. Br. 20-21, Claims App'x).

The Examiner relied on the following U.S. patents:

Flieger	5,789,048	August 4, 1998	("Flieger")
Smith	6,319,438	November 20, 2001	("Smith")

The Examiner also relied on Japanese application JP 04345828A (JP '828").

The Examiner rejected Appellants' claims 1, 3, 6, 43, 54, 55, 57-60, 66-68, 83, and 84 under 35 U.S.C. § 103(a) over Flieger.

The Examiner rejected Appellants' claims 1, 3, 6, 43, 54, 55, 57-60, 66-68, 83, and 84 under 35 U.S.C. § 103(a) over JP '828.

The Examiner rejected claims 69-72 under 35 U.S.C. § 102(e) over Smith.

Appellants' claim 1 recites¹:

A multilayer film or sheet comprising:
a.) a first co-extruded polymeric layer consisting essentially of an ionomer and a first additive; and
b.) a second co-extruded polymeric layer consisting of an ionomer and a second additive;
wherein the film or sheet is a thermoformable film or sheet having a thickness in the range of from about 8 mils to about 60 mils;
the first co-extruded polymeric layer is surface layer,
the second co-extruded layer is in contact with said first co-extruded polymeric layer, and
the first or second additive is one or more UV stabilizer, UV absorber, antioxidant, thermal stabilizer, anti-stat additive,

¹ Clam 1 has been modified to include indentations. *See* 37 C.F.R. § 1.75(i).

processing aid, fiber glass, mineral filler, anti-slip agent, plasticizer, nucleating agent, pigment, dye, flake, or mixtures thereof.

(Reply Br. 20, Claims App'x).

II. REJECTIONS UNDER 35 U.S.C. § 103(a) OVER FLIEGER

Findings of Fact

1. Flieger teaches a package made of multiple layers of extruded polymeric film, preferably ionomers of extruded polymers. (Flieger col. 1, ll. 62, through col. 2, ll. 3).

2. Flieger teaches that a layer of the bag can be black to provide for ultraviolet light protection and that another layer can be tacky to allow for minimal slippage when stacked on top of other bags. (Flieger col. 3, ll. 1-5).

3. Flieger teaches that the thickness of the layers of a bag can vary depending on the size and weight of the package, but that a typical bag holds 25 kg and has layers 70-125 microns thick. (Flieger col. 2, ll. 61-67).

Issue

Does Flieger render obvious a multi-layer film with a thickness “in the range of from about 8 mils to about 60 mils,” as claimed?

Analysis

Like the claimed multilayer film, Flieger teaches multiple polymeric layers of extruded ionomer arranged to form a package (FF² 1; Flieger col. 1, ll. 62, through col. 2, ll. 3) and including additives as claimed (FF 2, Flieger

² “FF” indicates Finding of Fact.

col. 3, ll. 1-5). Appellants argue that Flieger does not teach films or sheets that have the claimed thickness. (App. Br. 17). Flieger teaches layers that are 70-125³ microns thick. (FF 3; Flieger col. 2, ll. 61-67).

Flieger teaches that the thickness of the layers can be varied depending of the size and weight of the package, providing 70-125 microns as a typical thickness. (FF 3; Flieger col. 2, ll. 61-67). Even though Flieger discusses keeping the amount of polymer to a minimum in the final packaged product (*see* App. Br. 17; Flieger col. 3, ll. 9-11), it expressly teaches that the film thickness can be varied to accommodate packages of different sizes and weights. One skilled in the art would have had a reason to choose a greater thickness than the “typical” bag exemplified in Flieger when wishing to accommodate a package of a greater weight or size. Appellants do not argue that the claimed range produces unexpectedly good results for its disclosed utility. “[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art.” *In re Boesch*, 617 F.2d 272, 276 (CCPA 1980).

Accordingly, the Examiner did not err in rejecting claim 1 as being obvious over Flieger.⁴

³ The Examiner found that 125 microns is approximately 5 mils. (Ans. 15).

⁴ Appellants also argue that Flieger is not prior art, relying on the Rule 131 Declarations of inventor Lori J. Pike, which assert a date of invention before August 4, 1998. (App. Br. 18). Flieger was issued on August 4, 1998, more than one year before the filing date of Appellants’ provisional application 60/197,275, filed April 14, 2000, to which Appellants claim the benefit of priority. Thus, Flieger is prior art under 35 U.S.C. § 102(b). It is well settled that 102(b) prior art cannot be antedated. *In re Foster*, 343 F.2d, 980, 989 (CCPA 1965).

Appellants argue that Flieger does not teach the elements recited in dependent claims 6, 43, 57-60, 66-68, and 83⁵ (App. Br. 18-19). Appellants recite the elements of these claims but do not explain why the Examiner erred in finding the elements to be taught or obvious. Since the Appellants have not provided any specific arguments regarding these elements and instead have merely pointed out what the claims recite, we do not consider these claims to be separately argued. 37 CFR 41.37(c)(vii). Thus, the Examiner did not err in making these rejections.

III. REJECTIONS UNDER 35 U.S.C. § 103(a) OVER JP ‘828

The Examiner rejected claims 1, 3, 6, 43, 54, 55, 57-60, 66-68, 83, and 84 under 35 U.S.C. § 103(a) over JP ‘828. Because we affirm the Examiner’s rejection of the same claims as being obvious over Flieger, we need not and do not reach the issue of whether the rejection over JP ‘828 was proper.

IV. REJECTIONS UNDER 35 U.S.C. § 102(e) OVER SMITH

Findings of Fact

4. Appellants’ claim 69 recites: “The multilayer film or sheet of claim 1 wherein the first co-extruded polymeric layer has a Distinctness of Image (DOI) of at least 80 and a gloss that exceeds 60% at a 20 degree angle.” (App. Br. 21, Claims App’x).

⁵ Appellants also argued that the elements of claims 69-72 and 82 are not taught in Flieger (App. Br. 18), but claims 69-72 were not rejected over Flieger and claim 82 was cancelled by Appellants. Thus, we find these arguments to be superfluous and do not address them.

5. Smith teaches extruded automotive trim that can be made of several optional layers. (Smith abstract).

6. Smith provides an exemplary embodiment of a multilayer sheet, with a pigmented and/or metallized layer, a clear coat layer, a tie layer, and a protective layer. (Smith abstract, col. 9, ll. 51-56, and Figs. 11(e) and (f)).

7. Smith teaches that the layers are extruded into a sheet and thermoformed to the needed shape. (Smith col. 7, l. 52- col. 8, l. 5).

8. Smith teaches that the pigmented and UV resistant layers can be made of ionomer resins (Smith col. 15, ll. 17-25).

9. Smith teaches that the finished surface of the multilayer sheet can have a DOI of at least about 60 units, on a scale of 100 max. DOI, and a gloss reading of at least about 60-65 at an angle of 20°C. (Smith col. 19, ll. 46-65).

Issues

Does Smith teach a multilayer film or sheet with a first co-extruded polymeric layer has a DOI of at least 80?

Does Smith teach a multilayer film or sheet with layers having flow properties that are matched, allowing the layers to flow to the full width of the die?

Analysis and New Grounds of Rejection

Appellants argue that Smith is not available as prior art because Declarations by named inventor Lori J. Pike were submitted under 37 CFR § 1.131 to show a date of invention before the issue date of Smith. (App. Br. 4-5). Ms. Pike declares that she made runs of coextruded, two layer films comprising an ionomer and additives before August 4, 1998. (Rule 131 Declaration of Lori J. Pike executed July 9, 2007). Ms. Pike declares

that the two layers have a gloss that exceeds 60% at an angle of 20°C, but the Declarations do not include information about the DOI of the layers. (*Id.*). According to the Examiner, even though the Declarations are sufficient to antedate Smith for independent claim 1, which lacks a limitation on DOI, they are insufficient to antedate Smith because they fail to support the DOI recited in claims 69-72. (Ans. 7). Thus, the Examiner withdrew the rejection under 35 U.S.C. § 102(e) of claim 1, and other dependent claims, on the basis of Smith, but maintained the rejection of dependent claims 69-72 over Smith.

Appellants argue that the Examiner is wrong in assuming that “if a base claim reciting limitation A is not rejected, a dependent claim reciting extra limitations A+B can be rejected.” (Reply Br. 1). But, “the mere fact that an inventor may have invented the combination, A, B, and C, for example, before a patentee does not in itself prove that he has also invented the combination A, B, C, and D at the same time” *In re Tanczyn*, 347 F.2d 830, 832 (CCPA 1965). While Appellants argue that a Rule 131 Declaration is sufficient without showing all the limitations of each claim it is being used to support, “antedating affidavits must contain facts showing a completion of ‘the invention’ commensurate with the extent the invention is shown in the reference, whether or not it be a showing of the identical disclosure of the reference.” *In re Clarke*, 356 F.2d 987, 992 (C.C.P.A. 1966). Furthermore, “for the purpose of antedating [a reference] under Rule 131, it is sufficient that appellant has shown a reduction to practice of his basic invention, which showing will also suffice as to claims differing therefrom only in details which are obvious one of ordinary skill in the art.” *In re Spiller*, 500 F.2d 1170, 1178 (CCPA 1974).

Appellants do not argue or show that the DOI range recited in claims 69-72 is obvious over the multilayer film or sheet recited in their claim 1.⁶ Absent a showing that the additional limitations of claims 69-72 are obvious over the reduction to practice provided in the Rule 131 Declarations, the Declarations are insufficient to antedate Smith for claims 69-72.

Turning to the teachings of Smith, Appellants argue that Smith teaches only pigment additives and so cannot anticipate the film or sheet recited in claims 70-72 because they require a “clear” layer. Claims 70-72 ultimately depend on claim 6, which, in turn, depends from claim 1 and requires: “wherein said first co-extruded polymeric layer is *clear* and said second co-extruded polymeric layer comprises the polymer and an additive selected from pigment, dye, flake, or mixtures thereof.” (App. Br. 7-8; *see* App. Br. 20-21, Claims App’x (emphasis added)). Appellants do not point to, and we do not find, a definition of the term “clear” in the specification. Because claim 1, from which claim 6 depends includes pigments in the list of additives that can be added to the layers of the claimed multilayer film or sheet, we are not persuaded that a layer including pigment cannot also be a “clear” layer (that is, not opaque) within the scope of Appellants’ claims 70-72. Thus, the Examiner did not err in rejecting claims 70-72 because Smith does not teach a clear layer as claimed.

Appellants also argue that Smith teaches a multilayer sheet with a DOI of at least 60 units (FF 9; Smith Col. 19, ll. 58-64), but does not specify a DOI of “at least 80” as claimed. (App. Br. 8-9). Ranges taught in the prior

⁶ If Appellants were to show that the additional limitations were obvious over those recited in claim 1, then it would follow that claims 69-72 also would have been obvious over Flieger.

art that are broader than and fully encompass a claimed range have been found insufficient to anticipate the claimed range. *See Atofina v. Great Lakes Chem. Corp*, 441 F.3d 991, 999 (Fed. Cir. 2006). We are not persuaded that those of skill in the art would consider the broader range of at least 60 to have sufficient specificity to anticipate the narrower range claimed. Thus, Smith does not anticipate the multilayer films or sheets recited in claims 69-72.

Though Smith does not anticipate the range of DOI claimed, Smith presents a *prima facie* case for the obviousness of the claimed range because the range in Smith overlaps the claimed range. *In re Geisler*, 116 F.3d 1465, 1469-71 (Fed. Cir. 1997) (holding that a reference teaching a thickness of not less than about 100 Angstroms renders obvious a claimed range of 50 to 100 Angstroms). Accordingly, we enter a new grounds of rejection for claims 69-72 under 35 U.S.C. § 103(a) over Smith.

In addition, under this new grounds of rejection, even if layers of the films produced by co-extrusion in Smith are not inherently “matched,” as the Examiner finds (*see* Ans. 4 and 10), those of skill in the art would have had reason to match them to more easily form the layered sheet. Thus, this limitation of claims 71 and 72 would have been obvious over Smith.

V. ORDER

Upon consideration of the record and for the reasons given, the rejection of claims 1, 3, 6, 43, 54, 55, 57-60, 66-68, 83, and 84 under 35 U.S.C. § 103(a) over Flieger is AFFIRMED; and

the rejection of claims 69-72 under 35 U.S.C. § 102(e) over Smith is REVERSED.

We decline to reach a decision in the rejection of claims 1, 3, 6, 43, 54, 55, 57-60, 66-68, 83, and 84 under 35 U.S.C. § 103(a) over JP '828.

A new grounds of rejection is entered holding claims 69-72 under 35 U.S.C. § 103(a) over Smith.

Within two (2) months from the date of our decision appellant may further prosecute the application on appeal by exercise one of the two following options:

1. Request that prosecution be reopened by submitting an amendment or evidence or both. 37 CFR § 41.50(b)(1) (2008).
2. Request rehearing on the record presently before the Board. 37 CFR § 41.50(b)(2) (2008).

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2008).

AFFIRMED-IN-PART;

NEW GROUND OF REJECTION; 37 C.F.R. § 41.50(D)

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